

REMARKS

Claims 1-40 are pending with claims 1 and 34 being independent. Claims 1, 9, 10, 15, 20, 21, 25, 26, 28, and 34-37 have been amended and claims 38-40 have been added. Support for claims 38-40 may be found in the specification at the following locations.

Claim 38: Page 18, lines 5-7 and claim 25.
Claim 39: Page 18, lines 8-10 and claim 26.
Claim 40: Claim 28.

No new matter has been added.

Reconsideration and allowance of this application are requested in view of the foregoing amendments and the following remarks.

Claims 1, 20, 24, and 36 have been rejected under 35 U.S.C. §112, second paragraph for being indefinite. In response, applicant has amended claims 1 and 20 to more clearly recite the invention. Accordingly, applicant requests withdrawal of the rejection of claims 1 and 20. Additionally, the limitation of "the play pattern" in lines 2-3 of claim 24 finds antecedent basis in lines 8-10 of claim 1, which recites "the second game system providing a play pattern substantially different from a play pattern provided by the first game system." Therefore, applicant requests withdrawal of the rejection of claim 24. Moreover, applicant requests withdrawal of the rejection of claim 36 because the term "substantially" has been deleted from claim 36.

Independent claim 1 relates to a game having a toy figure, a first game system configured to communicate with the toy figure, and a second game system configured to communicate with the toy figure. The toy figure includes memory for storing information relating to the toy figure. The first game system is configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information. The second game system is configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information. The first game system includes a first design that, when

communicating with the toy figure, provides a first play pattern with a representation of the toy figure developed from the stored information. The second game system includes a second design that, when communicating with the toy figure, provides a second play pattern with the representation of the toy figure developed from the stored information, the second play pattern being different from the first play pattern.

Independent claim 34 relates to a game having a toy and a game system configured to communicate with the toy. The toy includes memory for storing information relating to the toy and a code that uniquely identifies the toy. The game system communicates with the toy, downloads the stored information relating to the toy, and receives input from a user relating to a representation of the toy. The game system also presents the representation of the toy when the game system communicates with the toy based on the stored information relating to the toy, receives the identification code, performs a play pattern procedure including controlling the representation of the toy when the game system communicates with the toy based on the received user input, the identification code and the downloaded information. Furthermore, the game system alters the stored information based on the received user input, the identification code and the downloaded information.

The Examiner has rejected claims 1-3, 5, and 7-37 as being obvious over U.S. Patent No. 5,752,880 (Gabai) in view of U.S. Patent No. 6,012,961 (Sharpe) or U.S. Patent No. 5,873,765 (Rifkin). Applicant requests withdrawal of this rejection because the references, alone or in combination, fail to describe or suggest providing a play pattern (claim 1) or performing a play pattern procedure (claim 34) with a representation of a toy when a game system communicates with the toy.

Gabai relates to a toy that communicates with a computer system. See Gabai at abstract and col. 2, lines 1-8. When the computer system does not communicate with the toy, the user may control operation of a representation of the toy through the computer system or the user may control operation of the physical toy directly through the toy without the use of the computer system. See Gabai at col. 9, lines 29-60 and Figs. 2A-2C. In contrast, when the computer system communicates with the toy, the user only may control operation of the physical toy indirectly through the computer system but cannot control operation of a representation of the toy through the computer system. See Gabai at col. 9, lines 29-60 and Figs. 2A-2C.

Accordingly, Gabai fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy.

Sharpe does not cure the deficiencies of Gabai because Sharpe also fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy. Sharpe relates to a toy that has re-writeable memory such that a user can download information from a computer into the toy memory to alter operating characteristics of the toy. See Sharpe at col. 1, lines 7-13. The physical toy can be operated indirectly by a user through the computer while "tethered" to the computer. See Sharpe at abstract; col. 2, lines 41-56; and col. 5, lines 14-27. The physical toy can be operated directly by a user when the toy is disconnected from the computer. See Sharpe at abstract; col. 2, line 57 to col. 3, line 8; and col. 5, lines 27-34. Therefore, Sharpe fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy.

Rifkin also does not cure the deficiencies of Gabai because Rifkin also fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy. Rifkin relates to a toy that has memory such that a user can download information from a computer to the toy memory to alter operating characteristics of the toy. See Rifkin at abstract, col. 3, lines 34-60; col. 5, line 58 to col. 6, line 14; and Figs. 1-3. Once the user downloads the information to the toy memory, the toy may be physically removed from the computer such that the toy and the computer do not communicate. See Rifkin at col. 3, lines 61-67; col. 6, lines 14-18; and Figs. 1-3. However, Rifkin never describes or suggests operating a representation of the toy. Thus, Rifkin fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy.

For these reasons, independent claims 1 and 34 are allowable over the combination of Gabai, Sharpe, and Rifkin. The remaining claims – 2, 3, 5, 7-33, and 35-37 – each depend from one of the independent claims and are allowable for at least the reasons that the independent claims are allowable and for containing allowable subject matter in their own right. For example, claim 9 recites that at least one of the game systems adjusts game play with the representation of the toy figure based on downloaded information relating to that toy figure.

None of the cited art describes or suggests adjusting game play with a representation of a toy figure based on downloaded information relating to that toy figure. As another example, claim 10 recites that the input received from a user includes input relating to control of the representation of the toy figure during game play. None of the cited art describes or suggests receiving input relating to control of the representation of a toy figure during game play.

The Examiner has rejected claims 4 and 6 as being obvious over Gabai in view of Sharpe, Rifkin, or Kikinis. Claims 4 and 6 depend from claim 1, which is allowable over Gabai in combination with Sharpe and Rifkin. Kikinis does not cure the deficiencies of Gabai to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy. Kikinis relates to a doll adapted to communicate with a computer. See Kikinis at abstract and col. 5, lines 16-25. When the doll is communicating with the computer, the user can control operation of the physical doll indirectly through the computer. See Kikinis at col. 3, lines 23-53 and line 66 to col. 4, line 17. However, Kikinis never describes or suggests controlling a representation of the doll. Thus, Kikinis fails to describe or suggest providing a play pattern or performing a play pattern procedure with a representation of a toy when a game system communicates with the toy.

For this reason, claim 1 is allowable over Gabai in view of Sharpe, Rifkin, or Kikinis. Claims 4 and 6, which depend from claim 1, are allowable for at least the reasons that claim 1 is allowable.

New claims 38-40 depend from claims 1 or 34 and are allowable for at least the reasons that claims 1 and 34 are allowable.

Attached is a marked-up version of the changes being made by the current amendment.

Applicant : Miriam MAWLE et al.
Serial No. : 09/556,839
Filed : April 21, 2000
Page : 8

Attorney's Docket No.: 06181-862002

Applicant asks that all claims be allowed. Enclosed is a \$54 check for excess claim fees and a \$110 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: September 9, 2002

Diana DiBerardino

Diana DiBerardino
Reg. No. 45,653

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

Version with markings to show changes made

In the claims:

Claims 1, 9, 10, 15, 20, 21, 25, 26, 28, and 34-37 have been amended as follows:

1. (AMENDED) A game comprising:

a toy figure that includes memory for storing information relating to the toy figure;

a first game system configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information; and

a second game system configured to communicate with the toy figure, download the stored information relating to the toy figure, receive input from a user, and alter the stored information based on the received input and the downloaded information[.];

wherein:

the first game system includes a first design that, when communicating with the toy figure, provides a first play pattern with a representation of the toy figure developed from the stored information,

the second game system [providing] includes a second design that, when communicating with the toy figure, provides a second play pattern [substantially] with the representation of the toy figure developed from the stored information, the second play pattern being different from [a] the first play pattern [provided by the first game system].

9. (AMENDED) The game of claim 1, wherein at least one of the game systems adjusts game play with [a] the representation of the toy figure based on the downloaded information relating to the [that] toy figure.

10. (AMENDED) The game of claim 1, wherein input received from a user comprises input relating to control of the representation of the toy figure during game play.

15. (AMENDED) The game of claim 1, wherein at least one of the game systems comprises a software game.

20. (AMENDED) The game of claim 1, further comprising one or more other game systems, each of the other game systems **[being]** configured to communicate with the toy figure and download the stored information relating to the toy figure.

21. (AMENDED) The game of claim 1, wherein received user input comprises an indication of an action that the representation of the toy figure takes during a game.

25. (AMENDED) The game of claim 1, wherein at least one of the game systems comprises a processor and a display that displays, under control of the processor, a visual representation of a toy figure coupled to the game system, the visual representation being based on the information downloaded from the toy figure.

26. (AMENDED) The game of claim 1, wherein at least one of the game systems comprises a processor and a speaker that emits, under control of the processor, an audio representation of a toy figure coupled to the game system, the audio representation being based on the information downloaded from the toy figure.

28. (AMENDED) The game of claim 1, wherein the toy figure comprises a three-dimensional **[representation of a]** character **[or a vehicle]** and the representation of the toy figure is a representation of the character.

34. (AMENDED) A game comprising:
a toy **[figure]** that includes memory for storing information relating to the toy **[figure]** and a code that uniquely identifies the toy **[figure]**; and
a game system configured to communicate with the toy **[figure]**, download the stored information relating to the toy **[figure]**, receive input from a user relating to a representation of the toy, present the representation of the toy when the game system communicates with the toy

based on the stored information relating to the toy, receive the identification code, perform a play pattern procedure including controlling the representation of the toy when the game system communicates with the toy based on the received user input, the identification code and the downloaded information, and alter the stored information based on the received user input, the identification code and the downloaded information.

35. (AMENDED) The game of claim 34, further comprising another game system configured to communicate with the toy **[figure]**, download the stored information relating to the toy **[figure]**, receive input from a user, receive the identification code, and alter the stored information based on the received input and code and the downloaded information.

36. (AMENDED) The game of claim 35, wherein the other game system provides a play pattern **[substantially]** the same as the play pattern provided by the game system.

37. (AMENDED) The game of claim 34, wherein the code is stored in the **[toy figure's]** toy's memory.

Claims 38-40 have been added as follows:

38. The game of claim 34, wherein the game system presents the representation of the toy by displaying a visual representation of the toy.

39. The game of claim 34, wherein the game system presents the representation of the toy by emitting an audio representation of the toy.

40. The game of claim 1, wherein the toy figure comprises a three-dimensional vehicle and the representation of the toy figure comprises a representation of the vehicle.